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IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

REPLY BRIEF

APPLICANTS: Sunil Thakur and Zul Momin
SERIAL NO.: 10/085,196
FILED: 02/27/2002
FOR: Business Systems & Methods For
Consumers/Vendors Interface via the Internet
To Automatically Provide Discounts
ART UNIT: 3622

SUNI 001 Reply Brief

CONTENTS

INTRODUCTION	1
ARGUMENT	1
CONCLUSION	6

BUMI 001 Reply Brief

**RECEIVED
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The Examiner's Answer fails to include in any cited prior art reference, or in any proper evidence of record, crucial elements of the method claimed herein; namely, the steps not done by a consumer, and the step of effecting a discount without action by the consumer.

As discussed in detail below, the claim rejections are based on mere conclusory statements, factual errors regarding alleged prior art teachings, and a lack of evidence.

Regarding certain claims (Claims 24, 25, 26 and 27), there is no proper evidence of record to invalidate these claims.

ARGUMENT**CLAIMS 23 - 25; 28 - 29**

The Examiner's Answer admits:

Kepecs does not disclose applying the discount without a selection from the consumer of any said applicable discount, and without requiring consumer awareness of any said applicable discount. (Examiner's Answer pp. 3, 4)

The Examiner's Answer admits that "In Kepecs the customer selects the discounts" (Examiner's Answer p. 12).

To remedy the deficiencies of the Kepecs reference, the Examiner's Answer relies on the Williams reference, a reference that deals solely with printed coupons which must be physically redeemed by a consumer. Kepecs teaches away from coupons (see Appeal Brief, Top Page 8).

The Examiner's reasoning in combining Williams and Kepecs is that:

It would have been obvious to one skilled in the art at the time the invention was made to add Williams to

Kepecs because both references deal with coupons and the automatic download thereof is an art recognized equivalent for delivering coupons on demand as taught by Williams.

The key phrase "deal with" is undefined in the Examiner's Answer.

Kepecs does not "deal with" coupons if by "deal with" is meant that Kepecs provides either a coupon or a method involving coupons. The Examiner's Answer admits that Kepecs and Williams attempt to solve different problems:

Contrary to argument at page 8, Kepecs and Williams are not incompatible just because the problems they seek to solve are different, since they deal both with the same field of discounts and incentives. (Examiner's Answer, p. 13)

From the fact that the Kepecs reference contains the word "coupons" it does not follow that Kepecs "deals with" coupons. The fact that Kepecs contains the word "coupons" is an insufficient basis to allege that a combination of teachings from Williams with those of Kepecs is proper.

Discounts & Coupons "Loosely" Equivalent ?

In the Examiner's Answer's, Section A (pp. 12 - 13) it is asserted that:

Further discounts and coupons are often used loosely as equivalent terms in the promotions art. See e.g. Sloane, US 5918211, (col. 2 lines 30-35) which discloses both coupons and discounts on loyalty cards similar to the ones of Kepecs system. (Examiner's Answer p. 13)

The Sloane reference was never cited against claims herein during prosecution of this application.

The cited text of the Sloane reference does not teach that "discounts and coupons are often used loosely as equivalent terms in the promotions art." It cannot be said, based on Sloane, that coupons and discounts are "loosely equivalent." Also,

even if this were so (which is denied) "Loose Equivalence" has never been accepted as a standard for an obviousness combination.

Regarding the assertions in the Examiner's Answer about the "implicit" teachings of Kepecs of payment delay and split dial-up, Appellants repeat here the discussion at pp. 8-9 of the Appeal Brief.

CLAIM 24

The Examiner's Answer's basis for the rejection of Claim 24 is as follows:

Claim 24. Kepecs discloses the system of claim 1.
Further Kepecs at least suggests means for calculating a future discount of the consumer based on a payment amount for the completed purchase. (See col 8 1. 12-46: targeting individual consumers based on past purchase histories) (Examiner's Answer p. 6)

The Examiner's Answer provides no reasoning or logic for the equation of Kepecs's "targeting individual consumers based on past purchase histories" and the claimed (Claim 24) actual calculation of a future discount for the consumer based on a payment amount for the completed purchase. Kepecs's "targeting" has nothing to do with (and provides no suggestion of) calculating a future discount or of basing such future discount on the payment amount of the purchase.

The Examiner's Answer relies on a factual error in these claim rejections. The Examiner's Answer states:

Contrary to argument at page 10, a synonym of "calculating" is "determining". Kepecs discloses at col. 8 lines 20-22, targeting so to determine "which kinds of customers should receive which (interpreted as future, since they are to be delivered) discounts" with the determining based on past purchases histories. Thus KEPECS's feature reads on "calculating a future discount

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for the consumer based on a payment amount for the completed purchase". (Examiner's Answer p. 16)

Although Appellants disagree that " 'calculating' is 'determining' ", this is beside the point. Kepecs in the quoted text has no teaching or suggestion of determining - the words "determine" and "determining" are not in the cited text. This is because Kepecs - in discussing "targeting" has nothing to do with determining a discount and, especially, has nothing to do with calculating a future discount as claimed in Claim 24.

A review of the text of Kepecs reveals it has no use of "determine" or "determining" (or any variants thereof) regarding discounts or calculations. Kepecs does use "determine" regarding establishing a "key". (Kepecs, Col. 10, line 33)

CLAIM 25

The Examiner's Answer's rejection of Claim 25 is as follows:

As to claim 25, providing the consumer with information about the future discount, once determined would have been obvious to inform the customer. (Examiner's Answer p. 6)

As to claim 25, implicitly, Official Notice was taken that it is customary to inform customers of information of relevance to them. Thus it was meant earlier that providing the consumer with information about the future discount, as claimed, would have been obvious, once the future discount is determined, to inform the customer of such discount. (Examiner's Answer p. 16)

These are merely conclusory statements with no evidence of record to support them. Alleged "Official Notice" is not a proper substitute for real evidence.

CLAIMS 26 - 27

These claims are rejected in an attempted combination of teachings of the Kepecs reference and the Hoffman reference.

Claims 26 and 27 require calculating an amount of a retirement account contribution (Claim 26) and making such a contribution (Claim 27). The Examiner's Answer admits the deficiencies of Kepecs regarding these claims:

As per claims 26-27, Kepecs does not disclose means for calculating an amount to a retirement account contribution for a consumer based on the transaction information or based on the calculated amount. (Examiner's Action p. 6)

The Examiner's Answers attempt to remedy the deficiencies of Kepecs in these regards again is based on merely conclusory statements and a lack of evidence in the record regarding retirement accounts and contributions to them:

However, Hoffman US 5297026 disclose giving rewards for purchases in the form of a percentage of the amount spent deposited in a customer account earning interest at a higher rate (abstract). Thus one skilled in the incentives arts would have known from Hoffman's teachings regarding the use of such incentives accounts to include retirement accounts such as to lure naive aging baby boomers to spend more. As to the basis of such reward being the nature of the transaction such marketing technique is well-known and obvious (e.g. use MasterCard, earn more rewards; buy particular product, earn more). (Examiner's Answer p. 7)

Hoffman has no teaching or suggestion regarding retirement accounts (words that do not appear in Hoffman). The Examiner's Answer admits the deficiency of Hoffman:

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Applicants argue retirement accounts are not taught by Hoffman. It is agreed Hoffman teaches only saving account. However, savings accounts obviously can be considered retirement accounts for aging baby boomers, as the Examiner implicitly meant above. (Examiner Answer, p.

18)

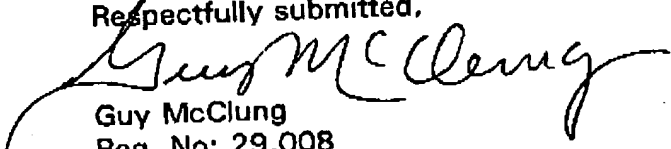
The statement about what can "obviously be considered" is again a mere conclusory statement based upon no evidence of record. The allegation that the "marketing technique is well-known and obvious" is not evidence upon which an obviousness finding can be based.

CONCLUSION

Applicants submit that what is now claimed herein is not obvious.

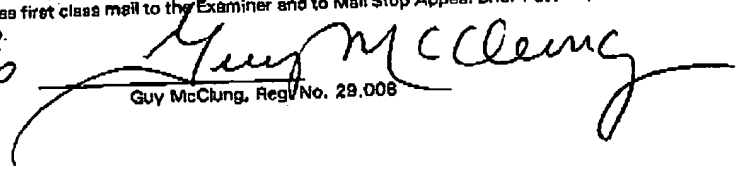
For the reasons discussed in detail above, Applicants respectfully submit that the Examiner's action should be reversed and the pending claims should be allowed.

Respectfully submitted,


Guy McClung
Reg. No: 29,008Date: 28 NOV 06

CERTIFICATE OF MAILING & FACSIMILE TRANSMISSION

This Reply Brief is being sent in reply to the Examiner's Answer and is being sent by facsimile transmission and by U.S. First Class Mail with sufficient postage as first class mail to the Examiner and to Mail Stop Appeal Brief-Patents; Commissioner of Patents; P.O. Box 1450; Alexandria VA 22313-1450.

Date: 28 NOV 06
Guy McClung, Reg. No. 29,008